REMARKS

Claims 1, 3-5, 7, 9, 11-12, 14-20, 22-27 and 30-35 are pending. Claims 2, 6, 8, 10, 13, 21 and 28-29 have been canceled. Claims 1, 5, 9, 11, 12, 15, 17 and 20 have been amended.

Claim Rejections - 35 U.S.C. § 102

The Patent Office rejected claims 1, 3-4, 8-11 and 28-35 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,243,761 B1 by Mogul et. al., ("Mogul").

Applicant respectfully traverses the rejection, however, claim 1 has been amended and claims 8, 10, 28 and 29 have been canceled, thus the rejections to claims 8, 10, 28 and 29 are now moot.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, "anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983). Emphasis added.

Applicant respectfully submits claim 1 includes elements that have not been taught, disclosed, or suggested by Mogul. For instance, claim 1 recites

1. A method for providing data files to a remote user over a channel comprising:
    determining a speed of a channel, said determining including sending a test on said channel and detecting a transfer time of said test on said channel;
    using said speed, estimating a transfer time for a data file;

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responsive to said transfer time for said data file, and based on an adjustable threshold defined by the remote user, determining whether to transfer either said data file or a compressed version of said data file, said adjustable threshold referring to a maximum delay for receipt of said data file;

receiving an indication from a user system as to what compression formats are decodable by said user system; and

transferring said data file or a compressed version of said data file, based on said transfer time for said data file and whether said transfer said for said file is within said adjustable threshold defined by the remote user, said compressed version of said data file being in conformity with compression formats decodable by said user system.

Applicant respectfully submits each element of claim 1 has not been taught, disclosed, or suggested by Mogul. Specifically, Mogul fails to teach, disclose or suggest an adjustable threshold defined by a remote user, the adjustable threshold referring to a maximum delay for receipt of the data file. Under *Lindemann*, a *prima facie* case of anticipation has not been established for claim 1. Claim 1 is believed allowable. Claims 3-5, 7, 9, 11 and 30-35 depend from claim 1, and thus are believed allowable.

Claim Rejections - 35 U.S.C. § 103

The Patent Office rejected claims 2 and 5 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,243,761 B1 by Mogul et. al., ("Mogul") in view of U.S. Patent No. 5,908,467 by Barrett et. al., ("Barrett").

Claim 2 has been canceled, thus the rejection is moot. Claim 5 is believed allowable due to its dependence upon an allowable claim 1.

The Patent Office rejected claims 6 and 7 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,243,761 B1 by Mogul et. al., ("Mogul") in view of Bentley et. al., "The freedom to choose: Transforming content on-demand in the BSCW shared Workspace system", ("BSCW").

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Claim 6 has been canceled, thus the rejection is moot. Claim 7 is believed allowable due to its dependence upon an allowable claim 1.

The Patent Office rejected claims 12-19 and 22-27 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,908,467 by Barrett et. al., ("Barrett") in view of Bentley et. al., "The freedom to choose: Transforming content on-demand in the BSCW shared Workspace system", ("BSCW").

Applicant respectfully traverses the rejection of claim 12 and claim 17, however, claims 12 and 17 have been amended. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970). Applicant respectfully submits claims 12 and 17 include elements that have not been disclosed, taught or suggested by the combination of Barrett and BSCW.

For instance, claim 12 recites:

12. A method for providing remotely accessible multimedia messages comprising:
    determining a speed of a channel, said determining including sending a test on said channel and detecting a transfer time of said test on said channel;
    determining a transfer time for available messages and attachments using the size of available messages and attachments and said speed;
    providing data representing a list of available messages to a user, wherein at least one listed message with a transit time greater than a threshold is provided with at least two compression options, said at least two compressible options being transferable within a user defined adjustable transit time threshold and being in conformity with compression formats decodable by a user system; and
    receiving from a user data indicating a desired compression option.

Applicant r spectfully submits each element of claim 12 has not been taught, disclosed, or suggested by the combination of Barrett and BSCW.

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Specifically, Barrett and BSCW fails to teach, disclose, or suggest, independently or in combination, providing at least two compressible options being transferable within a user defined adjustable transit time threshold and being in conformity with compression formats decodable by a user system. Under *In re Ryoka*, a *prima facie* case of obviousness has not been established for claim 12. Claim 12 is believed allowable. Claims 14-16 and 22-27 depend from claim 12, and thus are believed allowable.

Claim 17 recites:

17. A server system able to communicate adjustable sized messages to a client comprising:

an interface (220) able to connect over a channel (110) or an optional channel (110a) to a user system;

a test (140) sent over an active channel to determine a channel speed;

a timer (240) able to determine said channel speed;

two or more message files (252) of a determined size, selectable for presentation; and

one or more compressed message files (254), alternatively selectable for presentation, wherein at least one message file or compressed file is transferred to a client based on an adjustable threshold transit time defined by the client, said adjustable threshold transit time referring to a maximum delay for receipt of said data file at least one message file or compressed file.

Applicant respectfully submits each element of claim 17 has not been taught, disclosed, or suggested by the combination of Barrett and BSCW. Specifically, claim 17 recites at least one message file or compressed file is transferred to a client based on an adjustable threshold transit time defined by the client, said adjustable threshold transit time referring to a maximum delay for receipt of said data file at least one message file or compressed file. Under *In re Ryoka*, a *prima facie* case of obviousness has not been established for claim 17. Claim 17 is believed allowable. Claims 18-19 depend from claim 17, and thus are believed allowable.

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The Patent Office rejected claims 20-21 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,908,467 by Barrett et. al., ("Barrett").

Applicant respectfully traverses the rejection of claim 20 and claim 21, however, claim 20 has been amended, claim 21 has been canceled and thus the rejection is moot. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970). Applicant respectfully submits claim 20 includes elements that have not been disclosed, taught or suggested by Barrett.

For instance, claim 20 recites:

20. A method for presenting to a user a list (400) of messages for interacting with a multimedia message server comprising:

presenting to a user an identification (402) of a message available for transfer;

presenting, for said message, a sender information, a file format and an indication of a first transfer time (410) and a second transfer time (412), said second transfer time indicating time for transfer of a compressed message, determining said second transfer time based on a channel speed and a size of said compressed message; and

registering a user action indicating a compression option to be transferred.

Applicant respectfully submits each element of claim 20 has not been taught, disclosed, or suggested by Barrett. Specifically, claim 20 includes presenting, for said message, a sender information, a file format an indication of a first transfer time (410) and a second transfer time (412). Under *In re Ryoka*, a *prima facie* case of obviousness has not been established for claim 20, thus claim 20 is believed allowable.
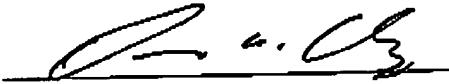
Conclusion

While it is believed that no fees are required, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 19-2179 of Siemens Corporation.

Respectfully Submitted,

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